Remarks

The disclosure is objected to. Claims 16-32 are pending in this case. Claims 16-32 are objected to. Claims 16-32 stand rejected under the doctrine of obvious-type double patenting and separately under 35 U.S.C. § 103.

Applicants have amended the application to overcome the Examiner's objection with respect to Applicant's disclosure.

Applicants have amended claim 16 to correct a minor informality and to overcome the Examiner's objection to claims 16-32.

Rejection of Claims 16-32 under Obvious-Type Double Patenting and 35 U.S.C. § 103

Applicants assert that the Examiner has not met the required burden to establish obviousness-type double patenting or a rejection under 35 U.S.C. § 103.

A rejection under the judicially created doctrine of obviousness-type double patenting is similar to a rejection under 35 U.S.C. § 103, as discussed by the Federal Circuit in *In re Longi*, 759 F.2d 887, 225 USPQ 644 (Fed. Cir. 1985). *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459, 467 (1966), defines the test for determining obviousness under 35 U.S.C. §103: Determine the scope and content of the prior art; ascertain the differences between the prior art and the claims at issue; and determine the level of ordinary skill in the art. The PTO bears the initial burden of establishing a *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). To establish a *prima facie* case, the Examiner must show (1) some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); (2) the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was

made. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200. 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991); and (3) the prior art reference or combination of references must teach or suggest all the limitations of the claims and all such teachings, as well as the expectation of success must come from the prior art, not applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

Applicants assert that the Examiner has not met the burden of establishing a *prima facie* case of obviousness. However, the issue is moot with respect to the obviousness-type double patenting rejections of claims 16-32 over US Patent Nos. 6,344,197, 6,008,199, 6,156,734, and 6,489,296 in that terminal disclaimers accompany this response. Likewise, the issue is moot with respect to the rejections under 35 U.S.C. § 103, as Applicants' agent of record hereby makes the required statement that the present application and US Patent Nos. 6,008,199, 6,156,734, and 6,489,296 were, at the time the invention was made, subject to an obligation of assignment to Eli Lilly and Company. According to the reasoning for the various outstanding rejections, the '197, '199, '734, and '296 Patents are integral in sustaining any and all rejections. Therefore, Applicants respectfully request that the above rejections be withdrawn and not be renewed.

Therefore, Applicants maintain that the Examiner has not established a *prima facie* case, and the cited references do not render the present invention obvious. In addition, the rejections are moot in view of the terminal disclaimers and the effective removal of '197, '199, '734, and '296 Patents as references as cited by the Examiner.

Conclusion

Having addressed all outstanding issues, Applicants respectfully request entry and consideration of the foregoing amendments and reconsideration and allowance of the case. To the extent the Examiner believes that it would facilitate

allowance of the case, the Examiner is invited to telephone the undersigned at the number below.

Respectfully submitted,

Thomas E. LaGrandeur
Agent for Applicants
Registration No. 51,026
Phone: 317-651-1527

Eli Lilly and Company
Patent Division
P.O. Box 6288
Indianapolis, Indiana 46206-6288

August 11, 2003

Attachments